

### **REMARKS**

Applicants acknowledge receipt of the Office Action dated December 13, 2004, which alleges that the instant application contains claims directed to three independent and distinct groups. More specifically, the allegedly distinct and independent groups include: Group I, including claims 1-6 and 32-62; Group II, including claims 7-20; and Group III, including claims 21-31.

In addition, the Examiner stated that if Group III is elected by Applicants, then Applicants must elect between three allegedly distinct species within Group III, where claim 21 is the generic claim.

With this Response, Applicants elect to prosecute the claims of Group I (claims 1-6 and 32-62) with traverse.

#### **I. Restriction Requirement is Improper**

35 U.S.C. § 121 permits the restriction of "two or more **independent and distinct**" inventions. *Accord* 37 C.F.R. § 1.141. Section 802.01 of the Manual of Patent Examining Procedure (8<sup>th</sup> edition, rev. 2) (hereinafter, "MPEP") provides that a restriction requirement is proper only if the different inventions are truly independent—*i.e.*, no disclosed relationship between the two or more subjects disclosed. In restricting the claims of the instant application, the Examiner asserts that the inventions claimed in Groups I, II, and III are distinct because "the search required for Group I is not required for Group II nor required for Group III." *Office Action* at 3. Applicants respectfully traverse. Every claim contained within Groups II and III is dependent on claim 1. Claim 1 is part of Group I, and therefore, the search required for Groups II and III will also be required for Group I. For at least this reason the restriction requirement is improper and the claims cannot be classified as independent.

#### **II. *Prima Facie* Case of Restriction is Not Met**

Examiners are permitted to establish a *prima facie* case for restriction by showing that each claimed invention is a member of a "separate classification", or alternatively, by showing that each

claimed invention has achieved "separate status in the art". MPEP § 803. In showing separate classification, the examiner is not required to cite patents. MPEP § 808.02(A). If each claimed invention is classifiable together however (i.e., separate classification is not possible), then the examiner must show separate status in the art by citing to patents that evidence such separate status. MPEP § 808.02(B).

In the instant application, the Examiner stated that the claims in Groups I and II are members of separate classifications. Particularly, the Examiner asserts that Group I claims are drawn to "an oscillator with temperature calculation circuits" classified in class 331, subclass 176, while the Group II claims are drawn to "an oscillator with heat sink for crystals" classified in class 331, subclass 69. *Office Action* at 2. Applicants respectfully traverse because claims from both Groups I and II can be fairly classified in both subclass 176 and subclass 69.

Class 331 is directed to oscillators in general, subclass 176 is directed to "temperature or current responsive means in [an oscillator] circuit," and subclass 69 is directed to "temperature modifiers" in oscillator circuits. *Manual of U.S. Patent Classification*.

By way of example, claim 12, which is a member of Group II, recites "a temperature maintenance device" that can be fairly classified as a "temperature responsive means" within subclass 176 as well as a "temperature modifier" within subclass 69 as suggested by the Examiner. Similarly, claim 5, which is a member of Group I, recites temperature compensation of the oscillation frequency, and therefore may be fairly classified as a "temperature modifier" within subclass 69 as well as a "temperature responsive means" within subclass 176 as suggested by the Examiner. Since claims from Groups I and II can be fairly classified together, Applicants respectfully submit that a *prima facie* case of restriction is not met because there is no citation of patents to evidence separate status in the art.

### III. Conclusion

Applicants respectfully request reconsideration and allowance of the pending claims and a timely Notice of Allowance be issued in this case. If the Examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, Applicants may have at times referred to claim elements in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other elements can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims.

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769.

Respectfully submitted,



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